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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-------------------------|
| 10/040,538 | 12/28/2001 | Stephen D. Pacetti | 50623.149 | 3811 |
| 7590 | 04/19/2006 | | EXAMINER | |
| Squire, Sanders & Dempsey L.L.P. Suite 300 One Maritime Plaza San Francisco, CA 94111 | | | | MICHENER, JENNIFER KOLB |
| | | ART UNIT | PAPER NUMBER | 1762 |

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/040,538 | PACETTI ET AL. | |
| | Examiner | Art Unit | |
| | Jennifer K. Michener | 1762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 1/31/2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7,9-11,13,15-26,33-70 is/are pending in the application.
- 4a) Of the above claim(s) 7,37-40,42,43,47 and 61-70 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,9-11,13,15-26,33-36,41,44-46 and 48-60 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Based on Applicant's amendments and arguments, claims 54-70 are rejoined with the elected group of the restriction requirement. Claims 61-70, however, are directed to the non-elected species and are withdrawn from consideration along with claims 37-40, 42-43, and 47.
2. Claims 7, 37-40, 42-43, 47, and 61-70 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.
3. Claims 1-6, 9-11, 13, 15-26, 33-36, 41, 44-46, and 48-60 are examined below.

Claim Rejections - 35 USC § 112

4. The rejection of claims 13, 16, 23-26, 33, 44-46, 48-53 under 35 U.S.C. 112, first paragraph, has been withdrawn.
5. The rejection of "directly" in claims 13, 16, 23-26, 33, 44-46, 48-53 under 35 U.S.C. 112, second paragraph, has been withdrawn, based on Applicant's clarification of arguments.

Examiner has interpreted the term "directly" given its broadest reasonable interpretation, despite the arguments of 3/30/05.

Claim Rejections - 35 USC § 102

6. Claims 1-6, 11, 13, 17-19, 21-24, 33-36, 44, 46, 48-54, 57-60, and 71-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Castro et al. (US 6,395,326). Examiner maintains the rejection of the previous office action for claims 1-6, 11, 13, 17-19, 21-24, 33-36, 44, 46, and 48-53.

As necessitated by amendment, claim 54 is added to this rejection for the same reasons as applied to claims 23, 33, 34, 44 and 51. Claims 57, 58, 59, and 60 are added to this rejection for the same reasons as applied to claims 46, 49, 50, and 48, respectively.

Claims 71-72 are added to this rejection because Castro's nozzle is capable of directing heat to discrete areas of the stent, with care taken not to actually touch the stent, requiring pointing the nozzle at the stent, but at least at some distance.

Claim Rejections - 35 USC § 103

7. Claims 9-10, 15-16, 20, 25-26, 41, 45, 55, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castro et al.

Examiner maintains the rejections of claims 9-10, 15-16, 20, 25-26, 41, and 45 for the reasons outlined in the previous office action.

Examiner adds claims 55 and 56 to this rejection, as necessitated by amendment, for the same reasons as applied to claims 41 and 45.

8. Claims 1-6, 9-11, 13, 15-26, 33-36, 41, 44-46, 48-49, 51-58, 60, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ding et al. (US 6,358,556) in view of You et al. (US 6,407,009).

Examiner maintains the rejection of claims 1-6, 9-11, 13, 15-26, 33-36, 41, 44-46, 48-49, 51-53.

Examiner adds claims 54-58 and 60 to this rejection for the reasons applied to claims 23, 33, 34, 44, 51, 41, 45, 46, 49, and 48.

Examiner adds claims 70-71 to this rejection because You teaches altering the temperature by providing bias gas from 126 via a gas inflow source 124 and out through the solvent injector 130. The outlet appears to be pointed at the substrate to be coated on the chuck 104 (see also, col. 5, line 65-col. 6, line 6).

Response to Arguments

9. Applicant's arguments filed 1/31/2006 have been fully considered but they are not persuasive.

Applicant argues that Examiner is speculating that Castro teaches blowing of gas and that Applicant's speculation that a glowing pin is used, instead of gas, is much more reasonable. Applicant argues that the conduit of Castro could be used for housing electrical wires, etc.; that the materials of Castro (metal, glass, high-temperature plastics) are more likely to be used with heating pins than gas blowers; and that it is difficult to regulate the flow of gas onto the discrete areas of Castro.

Examiner disagrees.

One of ordinary skill in the art, upon reading Castro, would immediately envision the use of heated gas. Castro teaches delivering heat from a heating control system to a heating nozzle via heat conduit.

The use of a glowing pin is not possible in the method of Castro. A glowing pin stuck into the nozzle of Castro runs counter to Castro's teachings. Castro teaches delivering heat from a heating control system to a heating nozzle via a conduit. The local heat provided by the glowing pin scenario of Applicant does not travel from a control system to a nozzle via a conduit. The conduit of Castro is not for housing electrical wires, but, rather, for conveying heat from the control system to the nozzle. Examiner also disagrees with Applicant's bold statement that metal, glass or high-temperature plastics would be more likely used with heating pins than gas blowers. Gas blowers such as hair dryers and leaf blowers are made of metal, glass, or high-temperature plastics. Additionally, Castro teaches the use of an "orifice" for application of heat. This orifice may be smaller or larger depending on the type of coverage desired. The orifice, or opening, of Castro would not be an opening if it were plugged with a glowing pin. Further, Castro does not merely teach heating discrete areas, which Applicant believes warrants the use of glowing pins. When reading that passage in context, Castro teaches the use of larger orifices for heating the entire surface of the prosthesis and smaller orifices for heating discrete areas. The smaller-sized orifice taught by Castro would be capable of regulating a discrete flow of gas. Examiner further notes that the hollow conduit of Castro inherently contains a gas. It is taught that heat is provided via that conduit. When heat is applied to gas, gas expands

and, in this case, would expand and exit via the nozzle of Castro onto the substrate of Castro, as required by the claim.

The use of a heated gas in the method of Castro is inherent.

Applicant takes issue with Examiner's argument regarding warm gas vs. liquid and argues that the absence of liquid does not require the use of gas.

Examiner apologizes for any confusion, however, maintains that her reasoning is valid. Castro teaches heat traveling from a heat system via a conduit, out a nozzle. Conduits in general, and Castro's in specific, convey fluid substances. A fluid is either a liquid or gas. Examiner's point is that since Castro conveys a fluid and that fluid is not a liquid, it is inherently a gas.

Applicant argues that Examiner has disregarded the claim limitation directed to selecting a gas temperature based on the solvent vapor pressure in regards to Castro. Examiner disagrees.

As outlined by Examiner Jolley, dimethylacetamide has a vapor pressure of less than 17.54 and Castro uses heating to induce evaporation, as claimed.

Applicant argues that gas is not directed to the substrate in You. This limitation is addressed above.

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Applicant asserts that Examiner is "making up the fact" that Ding is concerned with conformal or uniform coatings as Ding fails to even remotely discuss problems associated with application of coating to stents, such as cob-web formation between struts, etc.

Examiner disagrees.

Ding teaches in column 3, lines 16 and 53-57 that his coating process enables a thin layer of coating material to "adherently conform to and cover the entire surface of the filaments of the open structure of the stent but in a manner such that the open lattice nature of the structure of the braid or other pattern is preserved in the coated device" (emphasis added).

You teaches the desirability of creating thin, even coatings without pooling, and is combinable with Ding for the reasons of the previous office actions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer K. Michener whose telephone number is (571) 272-1424. The examiner can normally be reached Monday-Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer K. Michener
Primary Examiner
Art Unit 1762
April 17, 2006

jkf